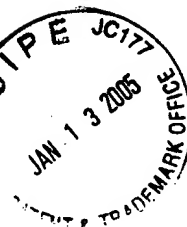




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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

REVIEWED BY
DOCK

mm 12-21-04

In re Application of ASANO et al
U.S. Application No.: 09/856,718
PCT Application No.: PCT/JP99/06616
Int. Filing Date: 26 November 1999
Priority Date Claimed: 27 November 1998
Attorney Docket No.: 0230-0161P
For: LAK ACTIVITY POTENTIATOR...

DECISION

This is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1.47(a)" filed 18 October 2004.

BACKGROUND

On 26 November 1999, applicant filed international application PCT/JP99/06616, which claimed priority of an earlier Japan application filed 27 November 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 08 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 27 May 2001.

On 25 May 2002, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 27 June 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 January 2002, applicant filed the present petition under 37 CFR 1.47(a) along with an executed declaration.

On 27 February 2002, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 17 August 2004, this Office mailed a decision dismissing the 28 January 2002 petition and vacating the Notification of Acceptance of Application Under 35 U.S.C. 371.

On 18 October 2004, applicant filed the present renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The renewed petition states that joint inventor Yutaka Tajima refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Tajima for signature (see affidavit of Hiroko Ejiri). Furthermore, the petition sufficiently illustrates Tajima's refusal to cooperate. Specifically, Tajima made an express oral refusal to cooperate during a telephone conversation with Ejiri (see Ejiri's affidavit). Thus, it can be concluded with reasonable certainty that Tajima refuses to join in the application.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 26 November 1999, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 28 January 2002.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459